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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**Applicant** : Darren DeWall  
**Appl. No.** : 09/967,249  
**Filed** : September 28, 2001  
**Title** : GAMING DEVICE THAT ALLOWS PLAYERS TO CHOOSE  
THE NUMBER OF CELLS PLAYED AND ADJUSTS THE  
PROBABILITY OF A SYMBOL APPEARING BASED ON  
THE NUMBER OF CELLS CHOSEN

**Grp./A.U.** : 3714  
**Examiner** : Corbett B. Coburn

**Docket No.** : 60,518-010

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**SUPPLEMENTAL BRIEF ON APPEAL**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

MAILSTOP: AF

Applicant submits the following arguments in support of this Supplemental Brief on Appeal in response to the Communication dated December 22, 2003.

**(1) Real Party in Interest**

This application was assigned by the inventor to Konami Gaming, Inc., as evidenced by the assignment recorded at reel **012512** frame **0926**.

**(2) Related Appeals and Interference's**

NONE

**(3) Status of Claims**

Claims **1-43** are on appeal and are attached hereto in the appendix.

#### **(4) Status of Amendments**

An amendment under Rule 116 was submitted and entered to correct the typographical error of “on” to —of— in claim 1. This amendment is reflected in the claims in the Appendix.

#### **(5) Summary of Invention**

A method and apparatus for playing a game wherein a player individually selects a number of cells (paragraph [0036] lines 1-2, lines 6-8 and lines 14-15; paragraph [0044] lines and 2) independently of one another from a plurality of cells and places a wager (paragraph [0038] lines 4-5; paragraph [0044] line 2) with respect to the selected number of cells. A symbol is randomly selected and displayed in each of the plurality of cells independently of the random selection of a symbol in each of the other cells (paragraph [0033] lines 1-3; paragraph [0044] lines 3-5). A prize is awarded to the player in response to a predetermined winning combination of symbols occurring within the selected number of cells (paragraph [0034] lines 1-3; paragraph [0044] lines 5-6). The game is distinguished by allowing a player to individually select the number of cells independently of one another to be evaluated by a game control to detect the presence of a winning combination within the selected number of cells (paragraph [0036] lines 1-4; paragraph [0044] lines 7-9).

#### **(6) Issues**

As to claims 1-11, 20-32 & 41-43, is the rejection under 35 USC §103(a) as being unpatentable over the patents to Payne et al. ‘607 in view of Giobbi et al. ‘925 proper?

As to claims 12-14, 18 & 33-35, and 38-39, whether the rejection under 35 USC

§ 103(a) as being unpatentable over the patents to Payne et al. '607 in view of Giobbi et al. '925 as applied to claims 11 or 32 and further in view of the patent '016 patent to Moody et al. is proper?

**(7) Grouping of Claims**

(A) Claims 1-11, 20-32 & 41-43 are grouped together to stand or fall together.

(B) Claims 12-14, 18 & 33-35, and 38-39 are grouped together to stand or fall together.

(i) Claims 15, 16, 19, 36, 37 and 40 are sub-grouped together to stand or fall together.

**(8) Argument**

**The Law**

The law is adequately set forth in the MPEP:

**2143.03 All Claim Limitations Must Be Taught or Suggested [R-1]**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837, F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**2142 Legal Concept of *Prima Facie* Obviousness [R-1]**

. . . The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness . . .

## ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §243 - §2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

### (A) Claims 1-11, 20-32 & 41-43

There can be no suggestion or motivation in either of the patents to modify Payne et al. '607 in view of Giobbi et al. '925 when neither reference suggests the individual selection of cells independently of one another. Said another way, it can not be obvious to individually select the number of cells to be placed in play independently of one another when the prior art only teaches the selection of a predetermined number of cells in a selected payline or in a randomly selected scattered "payline" pattern.

The examiner has not met the initial burden to provide some suggestion

of the desirability of to individually select the number of cells to be placed in play independently of one another as set forth in claims 1-11, 20-32 & 41-43. To the contrary, the examiner equates the selection of a number of cells in scattered payline to the individual selection of number of cells independently of one another when they are completely different. Additionally, there is no support for the conclusion that the claimed invention is directed to obvious subject matter. The references do not expressly or impliedly suggest the individual and independent selection of cells, nor does the examiner present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. The modification of the references suggested by the examiner is only possible in light of applicant's teachings. Furthermore, the modification of the games in the references would completely change the mode of operation of the respective games in references and it is fundamental that when the mode of operation of a reference is changed in a modification to anticipate a claim, that modification is not well founded.

**(B) Claims 12-14, 18 & 33-35, and 38-39**

In regard to claims 12-14, 18 & 33-35, and 38-39, not only does the combination of Payne and Giobbi fail, as discussed above, the addition of Moody et al '016 does not meet the limitations of these dependent claims. It can not be obvious to further modify the combination of Payne and Giobbi in view of Moody et al '016 to send a space ship to a randomly selected position when Moody et al merely show the moon, sun and stars *and no spaceship*. Furthermore,

the claims recite that the spaceship is sent to a randomly selected position. The examiner merely takes the broad position that since the Moody et al '016 patent teaches planets and stars, the use of spaceships is inherent. This rejection must fail because the examiner has not presented "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

**(i) Claims 15, 16, 19, 36, 37 and 40**

In regard to claims 15, 16, 19, 36, 37 and 40, the above rejections over Payne and Giobbi and Moody et al are added to by merely reaching the conclusion that the presentation of a pawnshop and its function as an evaluation station is obvious to a game designer in pursuit of player enjoyment. This is but a mere conclusion that one skilled in the art would have found a pawnshop used as an evaluation station to be obvious when there is no reason or suggestion to do so in the art. The prior art simply does not combine a spaceship and a pawnshop. Clearly, such a conclusion can only be reached in hindsight after viewing applicant's invention. The bare conclusion or assertion that the presentation of a pawnshop and its function as an evaluation station is obvious to a game designer in pursuit of player enjoyment, when not remotely suggested by the prior art, is outside the boundaries of the law as set forth above.

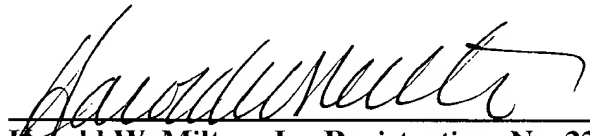
It is respectfully submitted that the rejections do not conform to the mandates of the MPEP as set forth above and that the rejections of the examiner should be reversed.

Respectfully submitted,

**HOWARD & HOWARD ATTORNEYS, P.C.**

**January 20, 2004**

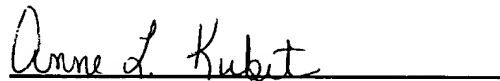
Date



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**CERTIFICATE OF EXPRESS MAILING**

I hereby certify that the enclosed **SUPPLEMENTAL BRIEF ON APPEAL** is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope as "Express Mail Post Office to Addressee", Mailing Label No. **EV318931022US** and addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, on **January 20, 2004**.

  
Anne L. Kubit

(9) Appendix

1.     **(Previously presented)**     A gaming assembly comprising;

          means for accepting a wager from a player;

          a display for displaying one of a plurality of symbols in each of a plurality of cells,

          a random generator for randomly selecting a symbol to be displayed in each of said cells independently of the random selection of a symbol in each of the other cells,

          a game control for controlling game play in a primary game mode and a secondary event mode for controlling images displayed on the display and detecting the presence of a predetermined winning combination of symbols and for awarding a prize in response to a winning combination, and

          a selector for allowing a player to individually select the number of cells to be independently of one another evaluated by the game control to detect the presence of a winning combination within the selected number of cells.

2.     **(Previously presented)**     An assembly as set forth in claim 1 wherein said plurality of cells includes three rows and three columns of cells and wherein said selector includes a sensor to allow the player to individually select a predetermined number of cells independently of one another.

3.       **(Original)**     An assembly as set forth in claim 1 wherein said game control is additionally arranged to trigger a secondary event mode in response to a secondary event trigger condition.

4.       **(Original)**     An assembly as set forth in claim 3 wherein said predetermined number of cells include one, three, five, seven or nine cells for selection by the selector.

5.       **(Original)**     An assembly as set forth in claim 1 wherein said display is a video display arranged to a simulation of a reel for each cell with each reel capable of presenting a plurality of said symbols.

6.       **(Original)**     An assembly as set forth in claim 1 wherein said random generator includes a symbol processor for changing the probabilistic distribution of symbols available for random selection and presentation in each of the cells in response to the number of cells selected by the player.

7.       **(Original)**     An assembly as set forth in claim 6 wherein said game control includes a pay-table defining winning combinations of symbols for each number of cells selectable by the player.

8.       **(Original)**     An assembly as set forth in claim 1 wherein said random generator includes a lucky symbol generator for selecting one said symbol as a lucky symbol for providing an increased prize in response to a winning combination including said lucky symbol.

9.       **(Original)**     An assembly as set forth in claim 1 including a predetermined number indicator for indicating on the display the number of cells selected by the player.

10.      **(Original)**     An assembly as set forth in claim 1 including a bet indicator for indicating the amount of a wager.

11.      **(Previously presented)**     An assembly as set forth in claim 3 including, in response to said secondary event trigger, the game control arranged to randomly select one of a plurality of positions and sending an object to one of said positions.

12.      **(Original)**     An assembly as set forth in claim 11 wherein said positions comprise representations of planets and said object comprises a space ship.

13.      **(Original)**     An assembly as set forth in claim 12 including an item selector for allowing the player to select a predetermined number of items.

14.     **(Previously presented)**     An assembly as set forth in claim 13 including an event programmer presenting an evaluation station and including a transfer device for moving the items through space to said evaluation station.

15.     **(Original)**     An assembly as set forth in claim 14 wherein said evaluation station comprises a pawnshop.

16.     **(Original)**     An assembly as set forth in claim 15 wherein said positions comprise representations of planets and said object comprises a spaceship and wherein said transfer device comprises the loading of said items onto said spaceship and said spaceship delivering said items to said pawn shop.

17.     **(Original)**     An assembly as set forth in claim 14 wherein said event programmer includes an award designator for awarding credits to said items at said evaluation station.

18.     **(Original)**     An assembly as set forth in claim 17 including a credit indicator for indicating the total number of credits awarded.

19.     **(Original)**     An assembly as set forth in claim 16 wherein said symbols include representations of a pawnshop, a spaceship, and at least one planet.

20. **(Previously presented)** A method for playing a game comprising the actions of;

a player individually selecting a number of cells independently of one another from a plurality of cells,

said player placing a wager with respect to said selected number of cells, randomly selecting and displaying a symbol in each of the said plurality of cells independently of the random selection of a symbol in each of the other cells,

awarding a prize to said player in response to a predetermined winning combination of symbols occurring within said selected number of cells.

21. **(Previously presented)** A method as set forth in claim 20 including triggering a secondary event in response to the occurrence of a secondary event trigger.

22. **(Original)** A method as set forth in claim 21 wherein the said secondary event trigger is the display of at least a predetermined number of a predetermined one of said symbols within said selected number of cells.

23. **(Previously presented)** A method as set forth in claim 20 wherein said selecting comprises individually selecting a predetermined number of cells.

24. **(Previously presented)** A method as set forth in claim 20 wherein selecting comprises individually selecting said nine cells.

25.     **(Previously presented)**     A method as set forth in claim 23 wherein said selecting a number of cells comprises selecting one, three, five, seven or nine cells independently on one another.

26.     **(Original)**     A method as set forth in claim 20 wherein said displaying comprises displaying as a video display a simulation of a reel for each cell with each reel capable of presenting a plurality of symbols.

27.     **(Previously presented)**     A method as set forth in claim 20 including said random generator changing the probabilistic distribution of symbols for presentation in each of the plurality of cells in response to the said selected number of cells.

28.     **(Original)**     A method as set forth in claim 27 including establishing a pay-table for each of the winning combinations of symbols within the selected number of cells.

29.     **(Original)**     A method as set forth in claim 20 including randomly selecting and displaying one the symbols as a lucky symbol and awarding an increased prize in response to a winning combinations of symbols within the selected number of cells including the lucky symbol.

30.     **(Original)**     A method as set forth in claim 20 including indicating on the video display the number of cells selected by the player.

31.     **(Original)**     A method as set forth in claim 20 including indicating the amount of a wager.

32.     **(Original)**     A method as set forth in claim 20 including randomly selecting one of a plurality of positions and sending an object to one of the positions in response to said secondary event trigger.

33.     **(Previously presented)**     A method as set forth in claim 32 including representing the positions as planets and the object as a space ship.

34.     **(Previously presented)**     A method as set forth in claim 32 including selecting a predetermined number of items.

35.     **(Original)**     A method as set forth in claim 34 including presenting an evaluation station and moving the items through space to the evaluation station.

36.     **(Original)**     A method as set forth in claim 35 including presenting the evaluation station as a pawn shop.

37.     **(Original)**     A method as set forth in claim 34 including presenting the positions as planets and the object as a spaceship and loading the items onto the spaceship and delivering the items to the pawnshop via the spaceship.

38.     **(Original)**     A method as set forth in claim 35 including displaying animations and awarding credits to the player in relation to the items delivered to the evaluation station.

39.     **(Original)**     A method as set forth in claim 38 including indicating the total number of credits awarded.

40.     **(Original)**     A method as set forth in claim 37 including presenting the symbols as a pawnshop, a spaceship, and at least one planet.

41.     **(Previously presented)**     A readable recording medium recording a control program for playing a video slot machine game on a display and comprising:

        a display for displaying one of a plurality of symbols in each of a plurality of cells,

        a random generator for randomly selecting a symbol in each of said cells independently of the random selection of a symbol in each of the other cells,

        a game control for awarding a prize in response to a predetermined winning combination of symbols,

a selector for allowing a player to individually select a number of cells independently of one another to be evaluated by the game control in determining the presence of a winning combination.

42.     **(Original)**     A medium as set forth in claim 41 wherein said random generator includes a symbol processor for changing the probabilistic distribution of symbols for presentation in the plurality of cells in response to the number of cells in said selected number of cells.

43.     **(Previously presented)**     A method for playing a game, comprising:  
presenting a plurality of selectable cells,  
individually selecting one or more of said cells independently of one another,  
randomly presenting a symbol in said cells,  
comparing said symbols in said selected cells with a schedule to determine one of a winning outcome, a losing outcome, and a bonus outcome, and  
rewarding credits according to said pay schedule in the event of a winning outcome being determined and ending the game in the event of a losing outcome, and initiating a bonus event when a bonus outcome is determined.